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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,348	02/22/2007	Ronald Leslie Mann	87951	1701

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EXAMINER	
MACARTHUR, VICTOR L	
ART UNIT	PAPER NUMBER
3679	

MAIL DATE	DELIVERY MODE
04/24/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/580,348	MANN, RONALD LESLIE	
	Examiner	Art Unit	
	VICTOR MACARTHUR	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) *26-28* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/9/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I, product claims 1-25, in the reply filed on 4/9/2009 is acknowledged.

Claims 26-28 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/9/2009.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 9, 12, 18, 19 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- The exemplary term "such as" (line 2 of claim 8) is unclear. It is impossible to determine what elements fall within the scope of "such as a z-section" and what elements do not. Is a c-section "such as a z-section"? Is a ball section "such as a z-section"?
- The term "has opposite side edge margin" (line 2 of claim 9) is improper English and unclear. Does applicant mean --has an opposite side edge margin-- or --has opposite side edge margins--?

- The pronoun “its" (claim 12) is unclear. What element does "its” refer to? The sheet? The plinth?
- The term “within the or” (line 4 of claim 18) is unclear.
- The word "means" (line 2 of claim 25) is preceded by the word(s) "infill" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Applicant is required to:
    - Amend the claims in accordance with MPEP 2181(I) to properly invoke 112 6th paragraph so that the phrase --means for-- or --step for-- is modified by functional language without being modified by sufficient structure, material, or acts for performing the claimed function; or
    - Delete the “means" language from the claims

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 9, 11, 12, 15-17, 20-23, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Gandara (U.S. Patent 5,494,261).

Gandara appears to disclose all of the applicant's claim limitations as best understood by the examiner (see 35 U.S.C. § 112 2nd paragraph rejections above).

The prior art structure is presumed to be fully capable of performing applicant's functional limitations (e.g., "to allow…" [claims 9 and 11]) in accordance with MPEP 2112.01(I).

Claims 1, 2, 4-6, 8-12, 15-22, 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Whitehead (GB 2323611).

Whitehead appears to disclose all of the applicant's claim limitations as best understood by the examiner (see 35 U.S.C. § 112 2nd paragraph rejections above).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 7, 13, 14 and 24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gandara (U.S. Patent 5,494,261).

The Gandara structure appears to fall within the scope of applicant's claimed dimensions. However, for the sake of argument, even if this were not the case note the following:

- It has generally been recognized that the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961).
- It has generally been recognized that a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).
- It has generally been recognized that a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).
- Furthermore, the applicant has failed to demonstrate criticality by any showing of unexpected result derived from any specific proportion, size, or shape over any other. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04.
- Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the prior art proportions, size and shape to that claimed by applicant since the limitations have no criticality and thus have been established by the case law cited above to be an obvious design consideration within the skill of the art. "[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8." In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

Note to Applicant Regarding Obviousness under 35 USC § 103

In order to overcome the above obviousness rejections above, applicant must show evidence of unexpected results which establish criticality in the limitations.

- Article I, Clause 8 of the United States Constitution clearly states "The Congress shall have Power... **To promote the Progress of Science and useful Arts**, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." (Emphasis added). Accordingly, patents can **only** be issued to the end of promoting science and the useful arts; *Kendall v. Winsor,* 62 U.S. (21 How.) 322, 328 *(1859); A. & P. Co. v. Supermarket Equipment Corp.,* 340 U.S. 147 *(1950).*
- Promotion of Science and the useful arts requires "more ingenuity than the work of a mechanic skilled in the art"; *Sinclair Co. v. Interchemical Corp.,* 325 U.S. 327, 330 *(1945); Marconi Wireless Co. v. United States,* 320 U.S. 1 (1943).
- Promotion of Science and the useful arts requires that inventions consisting of accumulations of old devices be given protection "only when the whole in some way exceeds the sum of its parts"; *A.&P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147 *(1950).*
- Underlying the constitutional tests and congressional conditions for patentability is the balancing of two interests-- the interest of the public in being protected against monopolies and in having ready access to and use of new items; versus the interest of the country, as a whole (not just inventors), in encouraging invention by rewarding creative persons for their innovations. Accordingly, patents can **never** be issued for

ordinary inventions with predictable results. "[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8." *In re KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 *(U.S. 2007)*.

- Accordingly, inventions are constitutionally **NOT** patentable for trivial details that lack criticality (unexpected results) since such random alterations would be expected in the ordinary progress of technology. "It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacturers. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith." *Atlantic Works v. Brady,* 107 U.S. 192, 200 *(1882)*; *A. & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147 *(1950)*.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

April 23, 2009

/Victor MacArthur/
Primary Examiner, Art Unit 3679